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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/681,323	10/09/2003	Scott J. Wolf	07883.0004-07	3366

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EXAMINER

BIANCO, PATRICIA

ART UNIT	PAPER NUMBER
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3762

DATE MAILED: 05/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/681,323

Applicant(s)

WOLF ET AL.

Examiner

Patricia M Bianco

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 46-85 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 46-85 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 46-69 & 85, drawn to delivery devices and methods of using to deliver conduits to heart wall, classified in class 606, subclass 108.
- II. Claim 70, drawn to a method for introducing a guidewire through coronary vessel, classified in class 606, subclass 153.
- III. Claims 71-84, drawn to fluid shunt/conduit/stent, classified in class 604, subclass 8.

The inventions are distinct, each from the other because of the following reasons:

Inventions I & II and II & III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions different modes of operation, or are different procedures, thereby resulting in different outcomes.

Inventions III and I are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a different process of using, such as draining fluid from the eye into the surrounding tissue.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

If applicant should choose to elect the invention of Group I, a further election of species is required.

This application contains claims directed to the following patentably distinct species of the claimed invention:

- Species A: Figures 1A-E, 3, 4, 5, 5A-5C
- Species B: Figure 2
- Species C: Figures 10A-C
- Species D: Figures 14A-B & 15
- Species E: Figure 7
- Species F: Figure 9
- Species G: Figures 16 & 16A
- Species H: Figures 16C & 16D
- Species I: Figures 16E & 16F
- Species J: Figures 16G-16 I
- Species K: Figures 16J -16N
- Species L: Figures 16O-16S
- Species M: Figures 17 & 18
- Species N: Figures 19A-19C
- Species O: Figures 20A-20B
- Species P: Figures 22, 22A & 22B
- Species Q: Figure 33A
- Species R: Figures 39A-39B

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claim is considered generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims

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readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

If applicant should choose to elect the invention of Group II, a further election of species is required.

This application contains claims directed to the following patentably distinct species of the claimed invention:

Species S:	Figures 6A & 6B
Species T:	Figures 6C & 6D
Species U:	Figures 6E & 6F
Species V:	Figures 6G & 6H
Species W:	Figure 8
Species X:	Figure 8A

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Species Y: Figure 8B
Species Z: Figure 8E
Species AA: Figure 8F
Species BB: Figure 8G
Species CC: Figure 8H
Species DD: Figures 8I-8K
Species EE: Figure 8L
Species FF: Figure 8M
Species GG: Figure 8N
Species HH: Figure 8O
Species II: Figure 8P
Species JJ: Figure 16B
Species KK: Figure 18A
Species LL: Figure 21
Species MM: Figure 23
Species NN: Figure 24
Species OO: Figure 25
Species PP: Figure 27
Species QQ: Figure 28
Species RR: Figures 29-32
Species SS: Figures 34 & 37
Species TT: Figure 35
Species UU: Figure 38
Species VV: Figure 41
Species WW: Figure 42
Species XX: Figure 43
Species YY: Figures 44A-44C
Species ZZ: Figure 48A
Species AAA: Figure 48B
Species BBB: Figure 48C
Species CCC: Figure 49
Species DDD: Figure 50A
Species EEE: Figure 50B
Species FFF: Figure 50C
Species GGG: Figure 51A
Species HHH: Figure 51B
Species III: Figure 51C
Species JJJ: Figure 51D
Species KKK: Figure 52
Species LLL: Figure 53
Species MMM: Figure 54

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claim is considered generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia M Bianco whose telephone number is (703)

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305-1482. The examiner can normally be reached on Monday to Friday 9:00-6:30, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on (703) 308-5181. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

May 13th, 2004

Patricia M Bianco
Primary Examiner
Art Unit 3762


PATRICIA BIANCO
PRIMARY EXAMINER 8/13/04